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EXAMINER

BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
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2178

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/964,753

Applicant(s)

CHAUCHARD ET AL.

Examiner

Adam L. Basehoar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-14 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-14, and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: The Amendment filed 12/11/06.
2. The rejection of claims 1-5, 8-14, and 17-19 under 35 U.S.C. 103(a) as being unpatentable over Lee (US-7,016,851 03/21/06) in view of the USPTO's, "Trademark/Service Mark Application, Principal Register, with Declaration", 08/22/00, pp. 1-11 (The Printed archived Web Pages show the automated USPTO's Trademark Electronic Application System and will hereafter be referenced as "TEAS") in further view of "Frequently Asked Questions About Trademarks", 02/11/00, pp. 1-42 (The printed archived Web Pages show the FAQ page linked from the corresponding TEAS system discussed above and will hereafter be referenced as "FAQ") have been withdrawn as necessitated by Amendment.
3. Claims 1-5, 8-14, and 17-19 are pending in the case. Claims 1, 14, and 19 are independent claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1, 8, 14, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 8, 14, and

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19, contain the newly amended limitations requiring the selecting and/or displaying of displayed heading or at least one official class, entered freely chosen wording, proposed wordings, and displayed number of at least one official class in a trademark registration application. The specification does not describe the situation wherein these items were displayed or selected "in" the trademark application. At best the specification of the invention teaches accomplishing these features "for" a trademark application to be created.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 8-14, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US-7,016,851 03/21/06) in view of the USPTO's, "Trademark/Service Mark Application, Principal Register, with Declaration", 08/22/00, pp. 1-11 (The Printed archived Web Pages show the automated USPTO's Trademark Electronic Application System and will hereafter be referenced as "TEAS") in further view of "Frequently Asked Questions About Trademarks", 02/11/00, pp. 1-42 (The printed archived Web Pages show the FAQ page linked from the corresponding TEAS system discussed above and will hereafter be referenced as "FAQ") in further view of Petruzzi et al (US-6,049,811 04/11/00).

-In regard to independent claim 1, Lee teaches a process for registering a trademark by means of a local computer (Fig. 2: 221) connected to a remote computer (Fig. 2: 231, 234, 241, 253, etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order:

entering the trademark (column 1, line 17; column 12, lines 30-31: i.e. through the filing of formal and technical documents pertaining to a trademark) to be filed at the national administrative department (Fig. 2: 241, 253: "EPO", "JPO");

sending the validated entry and selection (Fig. 2: 208A, 208B) to the remote computer via the network, the remote computer (Fig. 2: 231, 234: "Associate A", "Associate B") being disposed on a premises of an intellectual property attorney for reviewing the trademark application (column 2, lines 3-5: "attorneys or agents.....given jurisdiction"; column 8, lines 53-67; column 9, lines 1-9); and

retransmitted the validated entry and selection (Fig. 2: 209A, 209B) from the premises of the IP attorney (Fig. 2: 231, 234: "Associate A", "Associate B") to another remote computer to enable the application to be prosecuted at the national administrative department (Fig. 2: 241, 253: "EPO", "JPO").

Lee does not specifically teach wherein the entering of the mark was in a trademark registration application displayed on a local computer; selecting from the displayed trademark registration application at least one displayed heading of at least one official class of products or services to which the trademark applies; displaying a corresponding number of the selected at least one official class in the trademark registration application; and validating the entry and the selection. TEAS teaches entering of the mark was in a trademark registration application

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displayed on a local computer (Page 2: "Enter the mark here"); selecting the products or services (i.e. user could enter known Goods and/or services) to which the trademark applies from at least one of an official class (Page 4: "International Class" and "Listing of Goods and/or Services") and validating the entry and the selection (Page 8: "Validate Form"). TEAS also teaches wherein the corresponding number of the at least one official class could be displayed in the trademark registration application (Page 4: i.e. user could enter known corresponding class in the "International Class" entry box in the application). TEAS further teaches wherein displaying a corresponding number of the at least one official class via a search for acceptable identification of goods and services (Pages 10-11). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

Neither Lee nor TEAS specifically teaches selecting one displayed heading of official class of products. FAQ teaches that a user utilizing the TEAS system could select the "Listing of Goods and/or Services" link (Page 4) and retrieve the FAQ page from which a user could select one of a displayed heading of an official class of products (Pages 12-38: e.g. "Toys and sporting goods", "Meats and processed foods", etc.) It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of the TEAS system to have entered an official displayed heading of goods, because the headings listed by FAQ are an internationally

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recognized standard for classification and thus the classifications would be recognized by the national administrative office that the application was submitted to.

Neither Lee nor TEAS specifically teaches wherein the selecting was done within the registration application. Petruzzi et al teach a method for creating an intellectual property application (e.g. patent, copyright, trademark, service marks)(column 5, lines 12-16) wherein the act of selecting and displaying was done within the intellectual property application (Fig. 4: 290). It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of TEAS to have been able to select the displayed heading from within the application, because Petruzzi et al taught that selecting and displaying the available content of the intellectual property application in the application drafting area (Fig. 4: 290) provided an improved computer based aid in drafting an application as well as allowing drafting while reducing or avoiding the need of an attorney or agent (column 2, lines 33-35 & 60-62).

-In regard to dependent claim 2, Lee teaches cooperation between the local computer and the remote computer (Fig. 2).

-In regard to dependent claim 3, Lee teaches the validated entry and selection being re-transmitted from the remote computer to another remote computer by electronic mail (column 10, lines 59-67; column 11, lines 1-6).

-In regard to dependent claim 4, Lee teaches scanning formal documents for the trademark application (Fig. 2: 232). Lee does not specifically teach wherein the scanner was

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used to scan a model of the trademark. It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of the scanner of Lee, to have used it to scan the model of the trademark, because it was notoriously well known in the art at the time of the invention that for an application for a trademark to be complete a model/drawing/representation of the mark needed to be included in the application and that a scanner would be an alternative way to enter the model/drawing into the application.

-In regard to dependent claim 5, Lee teaches transmission to the remote computer of the scanned model of the trademark, via the computer network (Fig. 2).

-In regard to dependent claim 8, Lee does not teach entering at least one freely chosen wording in the displayed trademark registration application and comparing said freely chosen wording with the potential wordings contained in a file; displaying in the trademark registration application words proposed from among potential wordings; selecting at least one wording from among the displayed wordings proposed; and displaying the number of the official class corresponding to the wordings selected in the trademark registration application.

TEAS teaches:

entering at least one freely chosen wording (Page 4: "Listing of Goods and/or Services";
Page 10: "Please enter any word....services");

comparing said freely chosen wording with the potential wordings contained in a file
(Page 10: "searchable index");

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displaying words proposed from among potential wordings (Page 11: e.g. "Table Tennis Balls");

selecting at least one wording from among the wordings proposed (Page 11: i.e. user could select the identification code and listed potential goods which best matches search query term);

displaying the number of the official class corresponding to the wordings selected (Page 11: "028").

It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

Neither Lee nor TEAS specifically teaches wherein the displaying and selecting was done within the registration application. Petruzzi et al teach a method for creating an intellectual property application (e.g. patent, copyright, trademark, service marks)(column 5, lines 12-16) wherein the act of selecting and displaying was done within the intellectual property application (Fig. 4: 290). It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of TEAS to have been able to enter one freely chosen wording within the application and selecting a proposed wording displayed within the application, because Petruzzi et al taught that selecting and displaying the available content of the intellectual property application in the application drafting area (Fig. 4: 290) provided an improved computer based

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aid in drafting an application as well as allowing drafting while reducing or avoiding the need of an attorney or agent (column 2, lines 33-35 & 60-62).

-In regard to dependent claim 9, Lee does not teach file containing the wordings of the official classification of trademarks and the number of the class corresponding to each wording. TEAS teaches file (Page 10: "searchable index") containing wordings of classification of trademarks and the number of the class corresponding to each wording (Page 11). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

TEAS does not teach wherein the wordings of the file contain the official classification. FAQ teaches that a user utilizing the TEAS system could select the "Listing of Goods and/or Services" link (Page 4) and retrieve the FAQ page from which a user could select one of a displayed heading of an official class of products (Pages 12-38: e.g. "Toys and sporting goods", "Meats and processed foods", etc.) It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of the TEAS system have been shown the wordings of the official classification as a result of the search, because the headings listed by FAQ are an internationally recognized standard for classification and thus the classifications would be recognized by the national administrative office that the application was submitted to.

-In regard to dependent claim 10, TEAS teaches wherein the file further includes additional wordings not featuring in the official classification of trademarks and the number of the class corresponding to each of these additional wordings (Page 11: e.g. “028”, “Table tennis bats”, “Table tennis tables”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 11, TEAS teaches using comparison software permitting a display of a proposed wording identical with the freely chosen wording (Page 11: “table tennis” and “Table tennis”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 12, TEAS teaches wherein the comparison permits the display of a proposed wording including the freely chosen wording (Page 11: i.e. shows “Table

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tennis bats” and “Table tennis balls” with the freely chosen wording of “table tennis”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 13, TEAS teaches wherein the software permits the display of a proposed wording synonymous with the freely chosen wording (Page 11: e.g. “Table tennis paddles” and “Table tennis rackets”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to independent claim 14, Lee teaches a process for preparing a trademark application to be filed at a national administrative department (Fig. 2: 241, 253: “EPO”, “JPO”), (Fig. 2: 221) connected to a remote computer (Fig. 2: 231, 234, 241, 253, etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order:

entering the trademark (column 1, line 17; column 12, lines 30-31: i.e. through the filing of formal and technical documents pertaining to a trademark) to be filed at the national administrative department (Fig. 2: 241, 253: “EPO”, “JPO”);

sending the validated entry and selection (Fig. 2: 208A, 208B) to the remote computer via the network, the remote computer (Fig. 2: 231, 234: “Associate A”, “Associate B”) being disposed on a premises of an intellectual property attorney for reviewing the trademark application (column 2, lines 3-5: “attorneys or agents.....given jurisdiction”; column 8, lines 53-67; column 9, lines 1-9); and

retransmitted the validated entry and selection (Fig. 2: 209A, 209B) from the premises of the IP attorney (Fig. 2: 231, 234: “Associate A”, “Associate B”) to another remote computer to enable the application to be prosecuted at the national administrative department (Fig. 2: 241, 253: “EPO”, “JPO”).

Lee does not teach wherein the entering of the mark was in a trademark registration application displayed on a local computer; entering in the application at least one freely chosen wording for describing the products or services to which the trademark applies and comparing said freely chosen wording with the potential wordings contained in a file of at least one official class of products and services; selecting from the displayed application at least one wording from among the displayed wordings proposed and entering the selected wordings in the trademark application; displaying in the trademark registration application the number of the official class corresponding to the wordings selected in the trademark registration application; and validating the entry and the selection. TEAS entering of the mark was in a trademark registration application displayed on a local computer (Page 2: “Enter the mark here”); entering at least one

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freely chosen wording (Page 4: "Listing of Goods and/or Services"; Page 10: "Please enter any word....services"); comparing said freely chosen wording with the potential wordings contained in a file (Page 10: "searchable index"); displaying words proposed from among potential wordings (Page 11: e.g. "Table Tennis Balls"); selecting at least one wording from among the displayed wordings proposed (Page 11: i.e. user could select the identification code and listed potential goods which best matches search query term); displaying the number of the official class corresponding to the wordings selected (Page 11: "028"); and validating the entry and the selection (Page 8: "Validate Form"). TEAS also teaches wherein the selected wordings and the corresponding number of the at least one official class could be displayed in the trademark registration application (Page 4: i.e. user could enter the selected displayed wordings in the "Listing of Goods and/or Services" text box as well as the known corresponding class in the "International Class" entry box in the application). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

Neither Lee nor TEAS specifically teaches wherein the selecting was done within the registration application. Petruzzi et al teach a method for creating an intellectual property application (e.g. patent, copyright, trademark, service marks)(column 5, lines 12-16) wherein the act of selecting and displaying was done within the intellectual property application (Fig. 4: 290). It would have been obvious to one of ordinary skill in the art at the time of the invention for the

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user of TEAS to have been able to display in the application proposed wordings and selecting at least one wording from the displayed application, because Petruzzi et al taught that selecting and displaying the available content of the intellectual property application in the application drafting area (Fig. 4: 290) provided an improved computer based aid in drafting an application as well as allowing drafting while reducing or avoiding the need of an attorney or agent (column 2, lines 33-35 & 60-62).

-In regard to dependent claims 17 and 18, Lee teaches transmission to the remote computer (Fig. 2: 231, 234: "Associate A", "Associate B") an identity of the trademark applicant to complete the registration file and the retransmitting step includes transmission of the identity of the trademark applicant from the premises of the IP attorney (column 2, lines 3-5: "attorneys or agents.....given jurisdiction"; column 8, lines 53-67; column 9, lines 1-9) to the another remote computer (Fig. 2: 241, 253: "EPO", "JPO").

-In regard to independent 19, Lee teaches a process for registering a trademark by means of a local computer (Fig. 2: 221) connected to a remote computer (Fig. 2: 231, 234, 241, 253, etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order:

entering the trademark (column 1, line 17; column 12, lines 30-31: i.e. through the filing of formal and technical documents pertaining to a trademark) to be filed at the national administrative department (Fig. 2: 241, 253: "EPO", "JPO");

sending the validated entry and selection (Fig. 2: 208A, 208B) to the remote computer via the network, the remote computer (Fig. 2: 231, 234: “Associate A”, “Associate B”) being disposed on a premises of an intellectual property attorney for reviewing the trademark application (column 2, lines 3-5: “attorneys or agents.....given jurisdiction”; column 8, lines 53-67; column 9, lines 1-9); and

retransmitted the validated entry and selection (Fig. 2: 209A, 209B) from the premises of the IP attorney (Fig. 2: 231, 234: “Associate A”, “Associate B”) to another remote computer to enable the application to be prosecuted at the national administrative department (Fig. 2: 241, 253: “EPO”, “JPO”).

Lee does not specifically teach wherein the entering of the mark was in a trademark registration application displayed on a local computer; selecting from the displayed trademark registration application at least one displayed number of at least one official class of products or services to which the trademark applies and displaying a corresponding heading of the selected at least one official class in the trademark registration application and validating the entry and selection. TEAS teaches entering of the mark was in a trademark registration application displayed on a local computer (Page 2: “Enter the mark here”); selecting the products or services (i.e. user could enter known Goods and/or services) to which the trademark applies from at least one of an official class (Page 4: “International Class” and “Listing of Goods and/or Services”) and validating the entry and the selection (Page 8: “Validate Form”). TEAS also teaches wherein the corresponding number of the at least one official class could be displayed in the trademark registration application (Page 4: i.e. user could enter known corresponding class in the “International Class” entry box in the application). TEAS further teaches wherein displaying a

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corresponding number of the at least one official class via a search for acceptable identification of goods and services (Pages 10-11). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

TEAS does not specifically teach selecting a displayed one number of an official class and displaying a corresponding heading of the class in application. FAQ teaches that a user utilizing the TEAS system could select the "Listing of Goods and/or Services" link (Page 4) and retrieve the FAQ page from which a user could select one of a displayed official class number (i.e. "28", "29", etc) and selecting a displayed heading of an official class of products (Pages 12-38: e.g. "Toys and sporting goods", "Meats and processed foods", etc.) It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of the TEAS system have been shown the wordings of the official classification, because the headings listed by FAQ are an internationally recognized standard for classification and thus the classifications would be recognized by national administrative office that the application was submitted to.

Neither Lee nor TEAS specifically teaches wherein the selecting was done within the registration application. Petruzzi et al teach a method for creating an intellectual property application (e.g. patent, copyright, trademark, service marks)(column 5, lines 12-16) wherein the act of selecting and displaying was done within the intellectual property application (Fig. 4: 290). It would have been obvious to one of ordinary skill in the art at the time of the invention for the

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user of TEAS to have been able to select a displayed number from within the application, because Petruzzi et al taught that selecting and displaying the available content of the intellectual property application in the application drafting area (Fig. 4: 290) provided an improved computer based aid in drafting an application as well as allowing drafting while reducing or avoiding the need of an attorney or agent (column 2, lines 33-35 & 60-62).

Response to Arguments

8. Applicant's arguments with respect to claims 1, 14, and 19 have been considered but are moot in view of the new ground(s) of rejection.

-In general, the Applicant argues that neither the methods of Lee nor TEAS teach wherein the displaying and selecting was done within the actual registration application. As noted by the newly applied rejection under 35 U.S.C. 112, first paragraph, these features in the claims are believed to not comply with the enablement requirement. Regardless of the rejection under 35 U.S.C. 112, first paragraph, the Examiner believes that the Petruzzi et al reference teaches said limitations. Petruzzi et al generally teach benefits of an application drafting means wherein the selecting and displaying portion of the application drafting was done within the application.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

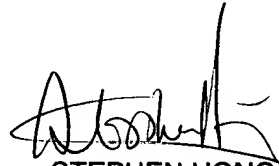
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB



STEPHEN HONG
SUPERVISORY PATENT EXAMINER